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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,014	10/31/2003	Maria Ronay	Y0R920030204US1 (20140-00)	8234
30678	7590	12/21/2004		EXAMINER MORILLO, JANELL COMBS
CONNOLLY BOVE LODGE & HUTZ LLP SUITE 800 1990 M STREET NW WASHINGTON, DC 20036-3425			ART UNIT 1742	PAPER NUMBER

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,014	RONAY, MARIA	
	Examiner	Art Unit	
	Janelle Combs-Morillo	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 13-29 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 021204.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date: _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to Ag product, classified in class 148, subclass 431.
 - II. Claims 13-29, drawn to process of fabricating a Ag alloy product, classified in class 148, subclass 678.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different process such as powder metallurgy.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Burton Amernick on August 30, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-29 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hensel (US 2,196,307).

Hensel teaches a silver alloy for electrical contacts (column 1 lines 1-7) comprising (in weight%): 1wt% Be and Ag, which meets the alloying element limitations of claims 1 and 2, and falls within the alloying ranges of instant claims 3-5. Be (inherently) meets the instant limitations of not forming a solid solution with silver or an intermediate phase under 700°C and diffuses to the surface at temperature of 400°C or below, substantially as claimed in instant claim 1.

Because the prior art teaches an example within the presently claimed alloying range, it is held that Hensel anticipates the presently claimed invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hensel (US 2,196,307).

Hensel teaches a silver alloy for electrical contacts (column 1 lines 1-7) comprising (in weight%): 0.1-5% Be and Ag (column 1 lines 47-49), which overlaps the alloy composition in instant claims 1-5. Be meets the instant limitations of not forming a solid solution with silver or an intermediate phase under 700°C, etc.

Overlapping ranges have been held to be a *prima facie* case of obviousness, see MPEP § 2144.05. It would have been obvious to one of ordinary skill in the art to select any portion of the range, including the claimed range, from the broader range disclosed in the prior art, because the prior art finds that said composition in the entire disclosed range has a suitable utility. Because Hensel teaches an overlapping alloy composition, it is held that Hensel has created a *prima facie* case of obviousness of the presently claimed invention.

9. Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hensel (US 2,196,307) in view of Tramposch.

Hensel is discussed in paragraphs above. Hensel does not teach forming a beryllium oxide layer on said Ag-Be alloy. However, Tramposch teaches that a beryllium oxide layer (column 1 line 67) can be formed on an otherwise easily corroded silver electrical contact (column 6 line 35) in order to prevent or inhibit the formation of tarnish (column 2 line 21). It would have been obvious to one of ordinary skill in the art to form a BeO layer, as taught by Tramposch, on the Ag-Be electrical contact alloy taught by Hensel, because Tramposch teaches said layer prevents or inhibits the formation of tarnish (column 2 line 21).

Concerning dependent claims 7, 8, 11, and 12, Hensel teaches the instant composition, as set forth above.

Concerning claims 9 and 10, though the combination of Hensel and Tramposch does not specify said Ag-Be alloy is located in a recess or a part of a BEOL structure, it is held to be within the scope of Hensel and Tramposch to have formed/used said Ag-Be contact alloy in a variety of electronic structure configurations, including being located in a recess or present in a BEOL structure, because said prior art teaches said alloy is useful for electrical contacts.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCM
November 28, 2004

G. Wysomierski
GEORGE WYSZOMIERSKI
PRIMARY EXAMINER